A DOCPHOENIX

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6/26/03

element qualifying as the special technical feature that defines a contribution over the prior art. He further asserted that the compounds contain a (4-methylsulfonylphenyl)imidazole which does not define a contribution over the prior art and that the substituents on the imidazole group vary extensively and, when taken as a whole, result in vastly different compounds. This election requirement is traversed.

As an initial point, Applicant notes that during the international examination of the PCT application from which this U.S. national stage application comes, a determination was made that the unity of invention requirements of the PCT rules had been satisfied. No objection was raised as to the group of compounds encompassed in claim 1, nor to providing claims to the compounds, a method for making them, of methods of treatment using those compounds in a single application. Applicants respectfully request that that determination not be disregarded.

Applicants respectfully submit that the determination of unity of invention made during the international phase was, indeed, the correct one. Contrary to the present examiner's assertion, the various compounds within the scope of the invention can be examined together without being an undue burden. All of the compounds have a core structure which can vary at only two positions on one ring (and the substituent at each of the two is such that in each instance the ring is an imidazole), and, contrary to the examiner's assertions, there are no provisos in the claims. The scope of the claims is clearly defined and thus can be perfectly understood.

Furthermore, although, as noted above, the examiner has asserted that the compounds defined by the claims "lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior

art," all of the compounds share a common novel structural element; i.e., each of the compounds is a substituted imidazole ring. That is, each ring is substituted by a phenyl-SO_2R_3 group and by a group R_1 and R_2, the latter being an aryl or heteroaryl ring. The examiner's statement that "the compounds claimed contain a (4-methylsulfonylphenyl)imidazole, which does not define a contribution over the prior art" simply is not correct.

Turning now to the specific groups defined by the examiner, he has divided claim 1 into three exemplary groups on the basis of the substituent of R_2. Applicants respectfully submit that all three of these groups can be searched and examined together because the core of the structure is not R_2 but the central imidazole ring, and according to the Manual of Classification the compounds are classified on the basis of this imidazole ring. They further would be classified on the basis of the -phenyl-SO_2R_3 group directly attached to the imidazole ring.

Accordingly, Applicants respectfully request that the examiner withdraw the election requirement and examine claim 1 in its totality. If the examiner remains unwilling to do so, applicants request that he examine the compounds of Groups I and II together (i.e., compounds in which R_2 is phenyl, naphthyl or pyridine).

In addition to dividing the compounds of claim 1 into several groups, the examiner also has asserted that each group further can include a single process for the preparation of the compounds and a single method of use. Applicants also traverse this requirement. Applicants respectfully submit that the various methods of use, i.e., the various disorders, diseases or conditions which can be treated or prevented through the administration of the compounds of the invention, clearly are unitary as they all relate to the same mechanism of action, i.e.,

inhibition of cyclooxygenase. In addition, examining all of these uses together would not impose an undue burden on the examiner; if the compounds are novel and unobvious, so must be all the methods of treatment or prevention set forth and claimed in the application.

Applicants further note that with regard to methods of preparing the compounds of this invention, the application sets forth only two: a method for preparing the compounds per se and a related method in which those compounds are reacted with an acid to produce the corresponding salts. There is no undue burden on the examiner to consider the preparation of the compounds and their corresponding salts at the same time.

Accordingly, Applicants respectfully request that, regardless of the scope of the compound claims the examiner is willing to substantively examine in this application, both method of preparation and all method of treatment or prevention claims be examined together for the compounds under consideration.

In order to be fully responsive to the outstanding Action, however, Applicants recognize that, although they traverse all parts of this election requirement, they must elect species as set forth by the examiner. Accordingly, Applicants elect the compounds of Group I (i.e., compounds in which R_2 is phenyl or

naphthyl), the method of preparing the compounds and a method for treating diseases mediated by cyclooxygenase.

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Attachment: Marked up copy of amendments